

## YOUNG CONAWAY STARGATT &amp; TAYLOR, LLP

BRUCE M. STARGATT  
 BEN T. CASTLE  
 SHELDON N. SANDLER  
 RICHARD A. LEVINE  
 RICHARD A. ZAPPA  
 FREDERICK W. IOBST  
 RICHARD H. MORSE  
 DAVID C. MCBRIDE  
 JOSEPH M. NICHOLSON  
 CRAIG A. KARNSITZ  
 BARRY M. WILLOUGHBY  
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 JEROME K. GROSSMAN  
 EUGENE A. DiPRINZIO  
 JAMES L. PATTON, JR.  
 ROBERT L. THOMAS  
 WILLIAM D. JOHNSTON  
 TIMOTHY J. SNYDER  
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NEILLI MULLEN WALSH  
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 MARTIN S. LESSNER  
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 C. BARR FLINN  
 NATALIE WOLF  
 LISA B. GOODMAN  
 JOHN W. SHAW  
 JAMES P. HUGHES, JR.  
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 JOHN T. DORSEY  
 M. BLAKE CLEARY  
 CHRISTIAN DOUGLAS WRIGHT  
 DANIELLE GIBBS  
 JOHN J. PASCHETTO  
 NORMAN M. POWELL

THE BRANDYWINE BUILDING  
 1000 WEST STREET, 17TH FLOOR  
 WILMINGTON, DELAWARE 19801  
 P.O. BOX 391  
 WILMINGTON, DELAWARE 19899-0391  
 (302) 571-6600  
 (800) 253-2234 (DE ONLY)  
 FAX: (302) 571-1253  
 \_\_\_\_\_  
 DIRECT DIAL: (302) 571-6689  
 DIRECT FAX: (302) 576-3334  
 jshaw@ycst.com

ATHANASIOS E. AGELAKOPOULOS  
 LISA A. ARMSTRONG  
 GREGORY J. BABCOCK  
 JOSEPH M. BARRY  
 SEAN M. BEACH  
 DONALD J. BOWMAN, JR.  
 TIMOTHY P. CAIRNS  
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 EDWARD J. KOSMOWSKI

JOHN C. KUFFEL  
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 ANDREW A. LUNDGREN  
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 D. FON MUTTAMARA-WALKER  
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 ADAM W. POFF  
 SETH J. REIDENBERG  
 MICHELE SHERRETTA  
 MONTE T. SQUIRE  
 MICHAEL P. STAFORD  
 CHAD S. C. STOVER (SC ONLY)  
 JOHN E. TRACEY  
 MARGARET B. WHITEMAN  
 SHARON M. ZIEG

SPECIAL COUNSEL  
 JOHN D. McLAUGHLIN, JR.  
 ELENA C. NORMAN  
 KAREN L. PASCALE  
 PATRICIA A. WIDDSS

SENIOR COUNSEL  
 CURTIS J. CROWTHER  
 OF COUNSEL  
 STUART B. YOUNG  
 EDWARD B. MAXWELL, 2ND

February 28, 2006

## BY CM/ECF

The Honorable Kent A. Jordan  
 United States District Court  
 844 N. King Street  
 Wilmington, DE 19801

Re: Cryovac, Inc. v. Pechiney Plastic Packaging, Inc., C.A. No. 04-1278-KAJ

Dear Judge Jordan:

*Smithkline Beecham v. Apotex Corp.*, No. 04-1522 (Fed. Cir. February 24, 2006), forwarded to you with Mr. Powers' letter of February 27, 2006, is indeed the case that Mr. Farabow, counsel for Cryovac, referred to at the oral argument in this case on December 16, 2005. Unfortunately, the *Smithkline v. Apotex* case did not decide the *Scripps/Atlantic Thermoplastics* conflict raised at that hearing. Nor does it support Pechiney's position on claim construction in this case.

In the slip opinion, the panel majority specifically states with regard to that conflict that "we need not address this controversy here." *Smithkline Beecham v. Apotex Corp.*, No. 04-1522, slip op. at 7 (Fed. Cir. February 24, 2006). Further, in the sentence immediately following that quoted at page 2 of Mr. Powers' letter, the panel majority stated that "we take no position on whether a product-by-process claim is construed with reference to the process steps." *Id.* at 12, n. 7. The majority opinion did, however, state that "if those product-by-process claims produced a different product than that disclosed by the '723 patent, there would be an argument that the '723 patent disclosure did not anticipate. *In re Luck*, 476 F. 2d 650, 653 (CCPA 1973)." In the present case, the Shah patent teaches that "orientation," as defined in the patent, is necessary to produce the properties desired in the final product. In fact Pechiney's own expert, Dr. Mount, has conceded that the properties of the final product change depending on how the orientation is accomplished. See D.I. 254, Ex. 221 at 57:20-59:6.

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The Honorable Kent A. Jordan

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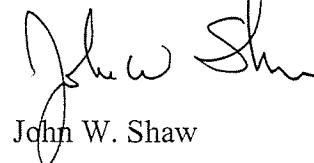
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Judge Newman's dissent does rationalize *Scripps* and *Atlantic Thermoplastics* and makes it clear that all claim limitations must be given effect.

We believe that *Smithkline Beecham* will be seeking en banc review of this decision, as the panel majority reached the decision of anticipation without first construing the claims at issue as Federal Circuit precedent requires. Anomalously, the panel majority's decision would allow a specific product to invalidate the patent claims, although the same product would not infringe the claims. In the past, the Federal Circuit has required that claims be interpreted the same for validity and infringement and has uniformly held that "that which infringes, if later, would anticipate, if earlier." See Judge Newman's dissent, at p. 2.

Thus, contrary to Mr. Farabow's hope as stated at the December hearing, the Federal Circuit did not resolve the *Scripps/Atlantic Thermoplastics* conflict, and we believe that Mr. Powers' letter incorrectly construes the applicability of the *Smithkline v. Apotex* case to the present one.

Respectfully submitted,



John W. Shaw

JWS:prt

cc: Clerk of the Court (by hand delivery)  
N. Richard Powers, Esquire (by hand delivery)  
Steven R. Trybus, Esquire (by e-mail)  
Ford F. Farabow, Esquire (by e-mail)